

REMARKS

Claims 1 through 31 are currently pending in the application.

This amendment is in response to the Office Action of April 26, 2004.

Claim Objections

Claim 15 is objected to due to informalities in the claim language. Appropriate correction has been made.

35 U.S.C. § 112 Claim Rejections

Claim 23 is rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants regard as the invention. Appropriate amendment of the claim has been made. Applicants assert that claim 23 clearly complies with the provisions of 35 U.S.C. § 112, second paragraph. Therefore, claim 23 is allowable.

35 U.S.C. § 101 Double Patenting Rejection

Claims 14 through 16, 18 through 22, 24, 25 and 27 through 31 are rejected under 35 U.S.C. § 101 as claiming the same invention as that of claims 1 through 12 and 15 through 26 of prior U.S. Patent 6,634,538 (hereinafter referred to as the '538 patent). Applicants respectfully traverse this rejection, as hereinafter set forth.

Applicants assert that a reliable test for statutory double patenting under 35 U.S.C. § 101 is whether a claim in the application can be literally infringed without literally infringing a corresponding claim in the patent. Is there an embodiment of the invention that falls within the scope of one claim, but not the other? If there is such an embodiment, then identical subject matter is not defined by both claims and statutory double patenting under 35 U.S.C. § 101 does not exist. *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

Applicants assert that statutory double patenting under 35 U.S.C. § 101 does not exist between the embodiments of the presently claimed inventions of presently amended independent claims 1, 7, and 14 and corresponding independent claims 1, 7, and 15 of the '538 patent because different embodiments of the invention are being claimed by such independent claims.

For instance, the embodiments of the presently claimed inventions of presently amended independent claims 1, 4, and 7 have an element of the claimed inventions calling for “providing self-leveling a resilient member located substantially above the upper clamping member” and “a self-leveling resilient member located substantially above a portion of the upper clamping member, the resilient member compressible by the upper clamping member for substantially causing the wirebonding window frame to engage portions of the leadframe located under the wirebonding window frame” whereas the embodiments of the inventions of corresponding independent claims 1, 7, and 14 of the '538 patent do not. Therefore, no statutory double patenting under 35 U.S.C. § 101 exists between the embodiments of the inventions of presently amended independent claims 1, 7, and 14 of the present application and the embodiments of the inventions of corresponding independent claims 1, 7, and 15 of the '538 patent. Accordingly, presently amended independent claims 1, 78, and 14 of the present application are allowable as well as the dependent claims therefrom.

Double Patenting Rejection Based on U.S. Patents. 6,126,062; 6,375,061; 6,588,649 and 6,634,538

Claims 1 through 13 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1 through 13 of U.S. Patent 6,126,062.

Claims 1 through 13 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1 through 13 of U.S. Patent 6,375,061.

Claims 1 through 13 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1 through 13 of U.S. Patent 6,588,649.

Claims 17, 23 and 26 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1 through 13 of U.S. Patent 6,634,538.

In order to avoid further expenses and time delay, Applicants elect to expedite the prosecution of the present application by filing Terminal Disclaimers to obviate the double patenting rejections in compliance with 37 C.F.R. §1.321 (b) and (c). Applicants' filing of the Terminal Disclaimers should not be construed as acquiescence of the Examiner's double patenting or obviousness-type double patenting rejections. Attached are the Terminal Disclaimers and accompanying fees.

Serial No. 10/616,078

Applicants request the allowance of claims 1 through 31 and the case passed for issue.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "James R. Duzan".

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